

Remarks

Claims 7-24 are pending in this application. The Examiner rejected claims 8, 10, 11, 12 and 22 under 35 U.S.C. § 112, ¶ 2. The Examiner also rejected claims 7-11, 13, 15, 16, 18, 21 and 23-24 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,114,788 to Vuillemin et al. in view of U.S. Patent No. 5,625,239 to Persson et al. and U.S. Patent No. 6,369,478 to Koharagi et al. The Examiner rejected claims 12, 19 and 20 as unpatentable over Vuillemin in view of Persson, Koharagi and further in view of U.S. Patent No. 6,392,370 to Bedini. The Examiner rejected claims 14, 17 and 22 over Vuillemin, Persson and Koharagi in view of the ordinary skill in the art. The Examiner also objected to the drawings.

With respect to the drawings, Applicants note that the originally filed drawings were erroneously numbered, *i.e.*, reference numeral 2 was inadvertently added as referencing the stator coils. As a result, virtually none of the reference numerals matched the elements to which they were referred in the specification. A corrected sheet of drawings is enclosed, showing corrected material in red ink, which corrects the error. Applicants have also attempted to make the drawings more clear for the Examiner by showing the stator housing in all four figures. Previously, the housing was thought to be understood to be a common element of all embodiments and was therefore omitted from Figures 2-4. However, for the sake of clarity, the housing 1 has been added. In addition, the terminal contacts 9 for each of the figures has been added. Applicants note that the position sensors between the coils (claim 23) is already disclosed in figures 1 and 2 wherein the sensors 6 are between the coils 5. Applicants also believe that the leads being led to a solvent-free space (claim 8) is easily understood with reference to the specification wherein the motor is in the presence of a solvent-containing liquid (such as fuel)

and the leads are led outside of the housing to an area free from such solvents. Applicants also note that the Examiner is correct that in figure 1, the sensor 6 comprises a conductor 8, and that they are the same component in the depicted embodiment. In an alternative embodiment, figure 2, the sensor 6 is a conducting wire 10 which is integral with the lead 11. Thus, the Examiner is technically correct that the sensor 6 and the lead 11 are depicted as the same component in that the embodiment depicts it as a single wire. This is fully described and clear from the specification. In figure 3, the magnet 12 and conductor 14 are separate, but the sensor 6 comprises the conductor 14 and are thus shown as the same component. This, too, is clear from the specification. Applicants believe that the drawings can now be easily understood with reference to the detailed description provided in the specification.

Applicants have overcome the Examiner's rejections under 35 U.S.C. § 112, ¶ 2. Specifically, claim 8 has been amended, without narrowing, to better define the solvent-free space by reference to the solvent environment in which the motor is operable. Claim 10 has been amended, without narrowing, to merely recite a "wire" for clarification. Claim 11 has been amended to incorporate the structure of claim 12 and more clearly depict the embodiment shown in figures 3 and 4 wherein the disk comprising permanent magnets and the position sensors are vertically displaced from the rotor (but still attached to the shaft for rotation). Finally, claim 22 depends from claim 18 wherein the conductors are copper wires. The conductors of claim 18 are different from the coils. Accordingly, Applicants submit that claim 22 is clear and definite. Claims 8, 9 and 11 have also been amended to depend from claim 7.

Applicants also note that the Examiner's rejection of claims 7-11, 13, 15, 16, 18, 21 and 23-24 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,114,788 to Vuillemin et al. in view of U.S. Patent No. 5,625,239 to Persson et al. and U.S. Patent No. 6,369,478 to Koharagi et al. should be withdrawn because Koharagi is not prior art to the present invention. Applicants are directed to the priority date for the present application, namely April 13, 1999 based upon German application 199 16 528.9. Acknowledgement of the claim for priority was made in the Office Action of January 3, 2002. Koharagi did not issue until April 2002 and has a filing date under 35 U.S.C. § 102(e) of February 27, 2001. Thus, Koharagi is not prior art. The rejections of claims 7-11, 13, 15, 16, 18, 21 and 23-24 must therefore be withdrawn because they rely on Koharagi.

Because claims 7 and 15 are patentable, claims 8-14 and 16-24 are patentable as dependant from patentable base claims. See MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Because this amendment places the application in condition for allowance and could not be presented sooner in light of the Examiner's new reliance on Koharagi, the present amendment should be entered under 37 C.F.R. § 1.116 and all claims allowed.

Applicant respectfully submits that the amendment herein demonstrates Applicant's preference for particular language and, notwithstanding anything to the contrary, are not intended to be amendments related to patentability. Furthermore, Applicant respectfully submits that the

amendments herein merely add language of equivalent scope, and that nothing herein is intended to narrow the scope of any of the claims.

The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and such fee should also be charged to our Deposit Account.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Shulman', written over a horizontal line.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit:
Kuehnel, et al.)	2834
)	Examiner:
Serial No.: 09/719,594)	Gonzalez, J.
)	
Filing Date: March 9, 2001)	
)	
For: ELECTRONICALLY)	
CONTROLLED ELECTRIC)	
MOTOR INTENDED FOR USE)	
IN AN ENVIRONMENT WITH)	
SOLVENTS)	

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REVISIONS TO CLAIMS 8-11

8. (Twice Amended) The electric motor as claimed in claim [1] 7, wherein the rotor and position sensors operate in the presence of one or more solvents and the connecting leads of the positions sensors are led to a [solvent-free] space outside the presence of solvents.

9. (Twice Amended) The electric motor as claimed in claim [1] 7, wherein the electrical conductor is a coil.

10. (Thrice Amended) The electric motor as claimed in claim 7, wherein the electrical conductor is a [pulse] wire arranged parallel to the shaft.

11. (Thrice Amended) The electric motor as claimed in claim [1] 7, further comprising position magnets comprising a second set of permanent magnets positioned on a disk, wherein the disk and position sensors are vertically displaced [separate] from the rotor and the disk is arranged for rotation about the shaft opposite the position sensors.